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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,846	06/27/2001	Donald J. Spencer	12868-002001	3704

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EXAMINER

BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/894,846	Applicant(s) SPENCER ET AL.	
	Examiner Alicia Baturay	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05112005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-64 are pending.

Claim Objections

2. Claim 34 is objected to because of the following informalities: Applicant states "...the user requests being supplied by a user *trough* a web browser..." It is thought Applicant meant to write "...the user requests being supplied by a user *through* a web browser...". Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-11, 14-38, 47, 49, 50, 52, 61, and 63 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-35 of copending Application No. 09/894,976. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 12-22, 27, 28, 33, 34, 38-45, 52-59, and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado et al. (U.S. 6,418,421).
7. With respect to claim 1, Hurtado discloses a system for delivery of media files to a particular digital media playback device, comprising: a content server operable to: receive device-identifying information obtained from a particular digital media playback device, and distribute media files in response to the received device-identifying information (Hurtado, col. 21, lines 21-30); and a download manager operable to: obtain device-identifying information from a particular digital media playback device that is in communication with the download manager, forward the obtained device-identifying information to the content

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server over a public communication network, receive media files over the public communication network from the content server (Hurtado, col. 21, lines 41-48), and distribute the received media files to the particular digital media playback device for playback on the particular digital media playback device (Hurtado, col. 14, lines 31-39).

8. With respect to claim 12, Hurtado discloses the invention substantially including the system where the download manager resides on a hardware platform and the digital media playback device is intermittently connected to the hardware platform (Hurtado, col. 14, lines 21-39).
9. With respect to claim 13, Hurtado discloses the invention substantially including the system where the download manager further is operable to cache downloaded media files locally on the hardware platform (Hurtado, col. 14, lines 21-39).
10. With respect to claim 14, Hurtado discloses the invention substantially including the system where the media file formats include MP3 files, WMA files, SAF files, BMT files, RM files, and VQF files (Hurtado, col. 9, lines 31-34).
11. With respect to claim 15, Hurtado discloses the invention substantially including the system where the digital media playback device is a portable device for playback of media files (Hurtado, col. 9, lines 28-30).

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12. With respect to claim 16, Hurtado discloses the invention substantially including the system where the digital media playback device is a non-portable home sound reproduction system (Hurtado, col. 9, lines 28-30).
13. With respect to claim 17, Hurtado discloses the invention substantially including the system where the digital media playback device is a cellular telephone (Hurtado, col. 9, lines 28-30).
14. With respect to claim 18, Hurtado discloses the invention substantially including the system where the digital media playback device comprises a television set top box (Hurtado, col. 9, lines 28-30).
15. With respect to claim 19, Hurtado discloses the invention substantially including the system where the digital media playback device is a web pad (Hurtado, col. 9, lines 28-30).
16. With respect to claim 20, Hurtado discloses the invention substantially including the system where the digital media playback device is an Internet radio device (Hurtado, col. 9, lines 28-30).
17. With respect to claim 21, Hurtado discloses the invention substantially including the system where the digital media playback device is a hybrid device (Hurtado, col. 9, lines 28-30).

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18. With respect to claim 22, Hurtado discloses the invention substantially including the system where the digital media playback device is a digital media playback module (Hurtado, col. 14, lines 26-27).
19. With respect to claim 27, Hurtado discloses the invention substantially including the system where the public communication network is the Internet (Hurtado, col. 9, lines 35-38).
20. With respect to claim 28, Hurtado discloses a method for delivery of media files to a particular digital media playback device, comprising: obtaining device-identifying information from a particular digital media playback device with a download manager that is in communication with the digital media playback device; forwarding the obtained device-identifying information from the download manager to a content server over a public communication network; receiving the device-identifying information at the content server; distributing media files from the content server to the download manager in response to the received device-identifying information (Hurtado, col. 21, lines 41-48); receiving the media files at the download manager; distributing the received media files to the particular digital media playback device for playback on the digital media playback device (Hurtado, col. 14, lines 31-39).
21. With respect to claim 33, Hurtado discloses the invention substantially including the method further comprising: displaying representations of media files that are playable on the digital media playback device to a user in a web browser (Hurtado, col. 75, lines 1-35).

22. With respect to claim 34, Hurtado discloses the invention substantially including the system where the application server further is operable to: receive user requests for controlling the function of the particular digital media playback device, the user requests being supplied by a user through the web browser; and generate control commands to the download manager, the control commands instructing the download manager to carry out the user requests on the particular digital media playback device (Hurtado, col. 75, line 47 – col. 76, line 2).

23. With respect to claims 38 and 52, Hurtado discloses the invention substantially including a system for providing media content to digital media playback devices, comprising: an application server for assembling media content and transmit the assembled media content to digital media playback devices (Hurtado, col. 11, lines 48-55), the application server being configured to: receive device-identifying information derived from a digital media playback device; securely authenticate the digital media playback device based on the received device-identifying information (Hurtado, col. 21, lines 21-30); obtain media content and usage rights (Hurtado, col. 21, lines 21-30); assemble the media content and the usage rights into a format that can be rendered on the authenticated digital media playback device; and transmit the assembled media content and usage rights to the digital media playback device (Hurtado, col. 21, lines 55-61).

24. With respect to claims 39 and 53, Hurtado discloses the invention substantially including the system where the application server further is configured to generate and distribute

instructions for remote management of the media content on the digital media playback device (Hurtado, col. 14, lines 21-39).

25. With respect to claims 40 and 54, Hurtado discloses the invention substantially including the system where the instructions for remote management comprise instructions to add specific media content to existing media content on the digital media playback device (Hurtado, col. 14, lines 21-39).

26. With respect to claims 41 and 55, Hurtado discloses the invention substantially including the system where the instructions for remote management comprise instructions to remove specific media content from the digital media playback device (Hurtado, col. 14, lines 21-39).

27. With respect to claims 42 and 56, Hurtado discloses the invention substantially including the system where the instructions to remove specific media content are generated in response to a request from a user (Hurtado, col. 14, lines 21-39).

28. With respect to claims 43 and 57, Hurtado discloses the invention substantially including the system where the instructions to remove specific media content are generated automatically (Hurtado, col. 14, lines 21-39) when a predetermined time period expires, if the specific media content on the playback device is time limited (Hurtado, col. 9, lines 53-62).

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29. With respect to claims 44 and 58, Hurtado discloses the invention substantially including the system where the instructions for remote management comprise instructions to change the sequence of media content that is listed in a playback list on the digital media playback device (Hurtado, col. 14, lines 21-39).

30. With respect to claims 45 and 59, Hurtado discloses the invention substantially including the system where the instructions for remote management comprise instructions to play back media content selected from existing media content on the digital media playback device (Hurtado, col. 14, lines 27-28).

31. With respect to claim 64, Hurtado discloses the invention substantially including the system where the user database further is operable to maintain information about the media content on the digital media playback devices (Hurtado, col. 21, lines 21-30).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 2-11, 23-26, 29-32, 35-37, 46-51, and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtado and further in view of Rezvani, et al (US 2002/0077077).

34. With respect to claims 2 and 50, Hurtado discloses the system where the content server comprises: a user database containing user information uniquely identifying one or more users (Hurtado, col. 21, lines 21-25); a content database containing multiple media files and metadata associated with each media file of the multiple media files (Hurtado, col. 12, lines 39-42); a usage rights database containing usage rights information for each media file in the content database (Hurtado, col. 20, lines 11-15); a license server for issuing content-enabling licenses (Hurtado, col. 9, line 66 – col. 10, line 4); and an application server operable to communicate with the user database, the content database, the license server, the usage rights database, the device database and the download manager (Hurtado, col. 11, lines 48-55). But Hurtado does not expressly disclose a database containing information on devices. However, Rezvani does teach a device database containing device information uniquely identifying one or more device types (Rezvani, page 12, paragraph 134). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hurtado with Rezvani in order to facilitate the registration of unique devices with a system that allows access to a network (Rezvani, page 1, paragraphs 4).

35. With respect to claims 3 and 29, the combination of Hurtado and Rezvani (Hurtado-Rezvani) discloses the invention substantially including the system where the application server is operable to perform the following steps in response to a request for one or more media files from the download manager: obtain user information from the user database based on the device-identifying information; obtain one or more encrypted media files and metadata associated with the encrypted media files from the content database; obtain usage rights

information for the one or more encrypted media files from the usage rights database (Hurtado, col. 21, lines 21-30); obtain device information from the device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); forward the obtained user and device information to the license server and receive a license for the encrypted digital media files (Hurtado, col. 21, lines 47-54); and distribute the encrypted media files and the license to the download manager over the public communication network (Hurtado, col. 21, lines 55-61).

36. With respect to claims 4, 30, 47, and 61, Hurtado-Rezvani discloses the invention substantially including the system where the application server is operable to perform the following steps in response to a request for one or more media files from the download manager: obtain user information from the user database based on the device-identifying information; obtain one or more encrypted media files and metadata associated with the encrypted media files from the content database; obtain usage rights information for the one or more media files from the usage rights database (Hurtado, col. 21, lines 21-30); obtain device information from the device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); forward the obtained user information to the license server and receive a license for the encrypted media (Hurtado, col. 21, lines 47-54); decrypt the encrypted media files using the received license; re-encrypt the decrypted media files, using the device information and usage rights information, to a file format that is playable only on the particular digital media playback

device; and distribute the re-encrypted media files to the download manager over the public communication network (Hurtado, col. 21, lines 55-61).

37. With respect to claims 5 and 31, Hurtado-Rezvani discloses the invention substantially including the system where the application server is operable to perform the following steps in response to a request for one or more media files from the download manager: obtain user information from the user database based on the device-identifying information; obtain one or more media files and metadata associated with the media files from the content database; obtain usage rights information for the one or more media files from the usage rights database (Hurtado, col. 21, lines 21-30); obtain device information from the device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); forward the obtained user and device information to the license server and receive a license for the digital media files (Hurtado, col. 21, lines 47-54); and distribute the media files and the license to the download manager over the public communication network (Hurtado, col. 21, lines 55-61).

38. With respect to claims 6, 32, 49, and 63, Hurtado-Rezvani discloses the invention substantially including the system where the application server is operable to perform the following steps in response to a request for one or more media files from the download manager: obtain user information from the user database based on the device-identifying information; obtain one or more media files and metadata associated with the media files from the content database; obtain usage rights information for the one or more media files

from the usage rights database (Hurtado, col. 21, lines 21-30); obtain device information from the device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); encrypt the media files, using the device information and usage rights information, to a file format that is playable only on the particular digital media playback device; and distribute the encrypted media files to the download manager over the public communication network (Hurtado, col. 21, lines 55-61).

39. With respect to claim 7, Hurtado-Rezvani discloses the invention substantially including the system of where the user database further contains offer information (Hurtado, col. 20, lines 11-15).
40. With respect to claim 8, Hurtado-Rezvani discloses the invention substantially including the system of where the device database contains device information uniquely identifying one or more type of devices, the device information comprising make, model, manufacturer, and functional characteristics (Rezvani, page 4, paragraph 48).
41. With respect to claim 9, Hurtado-Rezvani discloses the invention substantially including the system where the content server further comprises a web server that is connected to the application server and to the public communication network, thereby allowing a user to communicate with the content server through a web browser (Hurtado, col. 69, lines 52-61).

42. With respect to claim 10, Hurtado-Rezvani discloses the invention substantially including the system where the web server further is operable to provide representations of media files that are playable on the particular digital media playback device, the representations being operable to be viewed by the user in the web browser (Hurtado, col. 75, lines 1-35).
43. With respect to claim 11, Hurtado-Rezvani discloses the invention substantially including the system where the application server further is operable to: receive user requests for controlling the function of the particular digital media playback device, the user requests being supplied by a user through the web browser; and generate control commands to the download manager, the control commands instructing the download manager to carry out the user requests on the particular digital media playback device (Hurtado, col. 75, line 47 – col. 76, line 2).
44. With respect to claims 23 and 35, Hurtado-Rezvani discloses the invention substantially including the system where the device-identifying information is obtained from a removable nonvolatile storage medium in the digital media playback device (Rezvani, page 4, paragraph 48).
45. With respect to claims 24 and 36, Hurtado-Rezvani discloses the invention substantially including the system where the device-identifying information comprises a unique identification number obtained from the digital media playback device (Rezvani, page 4, paragraph 48).

46. With respect to claim 25, Hurtado-Rezvani discloses the invention substantially including the system where the unique identification number is a serial number (Rezvani, page 4, paragraph 48).
47. With respect to claims 26 and 37, Hurtado-Rezvani discloses the invention substantially including the system where the device-identifying information further comprises a state of a nonvolatile storage medium in the digital media playback device (Rezvani, page 4, paragraph 48).
48. With respect to claims 46 and 60, Hurtado-Rezvani discloses the invention substantially including the system where the application server is configured to obtain media content and usage rights by: obtaining user information from a user database based on the device-identifying information; obtaining one or more encrypted media files and metadata associated with the encrypted media files from a content database; obtaining usage rights information for the selected media files from a usage rights database (Hurtado, col. 21, lines 21-30); obtaining device information from a device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); where the application server is configured to assemble the media content and the usage rights by: forwarding the obtained user and device information to a license server and receiving a license for the encrypted digital media files (Hurtado, col. 21, lines 47-54); and where the application server is configured to transmit the assembled media content and

usage rights by: transmitting the encrypted media files and the license to the digital media playback device over a public communication network (Hurtado, col. 21, lines 55-61).

49. With respect to claims 48 and 62, Hurtado-Rezvani discloses the invention substantially including the system where the application server is configured to obtain media content and usage rights by: obtaining user information from a user database based on the device-identifying information; obtaining one or more media files and metadata associated with the media files from a content database; obtaining usage rights information for the selected media files from a usage rights database (Hurtado, col. 21, lines 21-30); obtaining device information from a device database, the device information describing functional capabilities of the digital media playback device (Rezvani, page 12, paragraph 134); where the application server is configured to assemble the media content and the usage rights by: forwarding the obtained user and device information to a license server and receiving a license for the digital media files (Hurtado, col. 21, lines 47-54); and where the application server is configured to transmit the assembled media content and usage rights by: transmitting the media files and the license to the digital media playback device over a public communication network (Hurtado, col. 21, lines 55-61).

50. With respect to claim 51, Hurtado-Rezvani discloses the invention substantially including the system where the user database further is operable to maintain information about the media content on the digital media playback devices (Hurtado, col. 21, lines 21-30).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
May 13, 2005


BHARAT BAROT
PRIMARY EXAMINER